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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	3

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/583,334	Applicant(s) KEITHLY ET AL.	
	Examiner Helen F. Pratt	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. 119(a)-(d) or (f).

a)☐ All b)☐ Some *c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then is followed by the use of narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, 21, and recites the broad recitation " and before the peak harvesting season for late season round orange fruit " and the claim also recites " including Hughes Valencia and Rhode Red Valencia orange fruit " which is the narrower statement of the range/limitation.

MISCELLANEOUS

The title should be amended to contain a reference to the method.

The terminal disclaimer has been received and approved.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventura et al. in view of Citrus Industry , June 99 and Pao et al..

The claims are rejected for the reasons of record cited in the last office action. The limitations added to the claims have been discussed in the last office action. Claim 21 and 26 further requires a particular color number. However, this is a well known color number cited as preferable by Citrus Growers, and that it would be helpful to have cultivars that mature ahead of the Hamlin orange with a 36 color score in Nov. Bonaventura et al. disclose that it is known to use mid season fruit and to blend it with other juices from the two other growing seasons (page 284, 3rd col. 1st complete para.). Therefore, it would have been obvious to blend juices from the various seasons and to use a particular color score to make the required product.

ARGUMENTS

Applicant's arguments filed 6-28-01 have been fully considered but they are not persuasive. Applicants argue that their invention uses mid-season round orange cultivars, which are Vernia, and Frost cultivars. However, the independent claims are broader than this as in the 112 rejection. Applicants are not the first to recognize that Vernia and Frost cultivars are mid-season round oranges. No claim has been made

that they are the inventors of these cultivars. The reference to Bonaventura et al. disclose that it is known to use mid-season oranges and to mix the juice with other juices (abstract). Certainly, gathering information as to sensory data is within the skill of the ordinary worker (Citrus Industry), which contains such information. The Bonaventura et al. reference is used in combination with Citrus Industry, which states that it would have been helpful to have a cultivar, which matures ahead of the Hamlin orange, and that a 36 color number is desirable.

Even though the primary reference is to blood oranges, the concept is known of using the mid-season oranges. The brix, acidity, pH, total sugars, etc. are analyzed on the starting samples.

It is not seen that in Bonaventura, that the test blends of blood orange cultivars were not made to enhance the sensory characteristics of the final blend. Brix, colors, acidity, are all well known factors, and all are commonly used to determine final blends.

Applicants argue that none of the articles recognize the Vernia cultivar as being anything other than a Valencia variety or recognize the Frost cultivar. . However, certainly, anyone that grows such a cultivar knows when it ripens, as this is an inherent characteristic of the orange. Certainly, they intend that the orange be used for its known function of making juice. There would be no point in growing such an orange if there wasn t a market for it. Bonaventura discloses that it is known to use such midseason oranges in making juice blends.

Any inquiry concerning this communication should be directed to Helen F. Pratt at telephone number 703-308-1978. hp 7-30-01

H. Pratt

HELEN PRATT
PRIMARY EXAMINER